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09/911,949	07/24/2001	Thomas Louis Russo		5696

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A8-5

Office Action Summary

Application No.

09/911,949

Applicant(s)

RUSSO, THOMAS LOUIS

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 112 rejection of claims 1, 2 and 4 of record in Paper #2, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendments in Paper #3.
2. The 35 U.S.C. 102 rejection of claims 1 and 2 as anticipated by Jaszai of record in Paper #2, Page 3, Paragraph #4 has been withdrawn due to Applicant's amendments in Paper #3.
3. The 35 U.S.C. 103 rejection of claim 3 over Jaszai of record in Paper #2, Pages 3 – 4, Paragraph #6 has been withdrawn due to Applicant's amendments in Paper #3.
4. The 35 U.S.C. 103 rejection of claim 4 over Magid of record in Paper #2, Pages 5 – 6, Paragraph #7 has been withdrawn due to Applicant's amendments in Paper #3.

New Rejections

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The phrase “may be” in claim 1 and 4 is unclear, which renders the claim vague and indefinite. The phrase “may be” in the claim allows the zone to be a single inflatable chamber. None of the language in the claim requires multiple zones to be present in the packing pad. It is optional language, and therefore, single zones are still will read upon the claim language.

Correction/clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaszai (USPN 5,826,723).

Jaszai discloses two flexible wall members, film (Column 12, lines 7 – 10), placed next to each other and sealed together through heat-sealing along the perimeters and through the internal area making two separate inflatable areas (Column 4, lines 1 – 7 and Figure 20, #14) which form an impact resistant wrapping, packing, system (Column 3, line 63). The wrapping system contains an intake tap for each of the separated inflatable areas (Column 7, lines 36 – 38 and Figure 20, #3). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 20, #3 and 5), allowing the wrapping system to be

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reused (Column 2, lines 22 – 25). The areas have also been adapted to redistribute the air through the formed chambers when pressure has been applied to the chambers (Column 7, lines 41 – 47). Jaszai discloses the claimed wrapping system above including the chambers maximizing available pad surface (Figure 20, #14); however, Jaszai fails to disclose the chambers being substantially conical in shape.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of the invention to change the shape of the chambers of the inflatable packing pad.

One skilled in the art would have been motivated to do so in order to use the entire inflatable space formed when the two pieces are sealed together.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Magid (USPN 4,629,433).

Magid discloses a central wall member made from film (Column 4, lines 52 – 54), where individual sheets of plastic are placed next to each other and sealed to the central layer (Column 4, lines 54 – 56), forming a first layer through heat-sealing along the perimeters (Column 4, lines 30 – 33) making separate inflatable areas (Figure 4, #22 and Column 4, lines 54 – 56) which form an impact resistant wrapping, packing, system. The inflatable article contains an intake tap for each of the separated inflatable areas (Column 4, line 56 and Figure 4, #23). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 4, #23), allowing the wrapping system to be reused (Column 6, lines 60 – 65). However, Magid fails to disclose a second layer on the opposite side of the central layer to form at least four separate areas within the inner pad volume.

Magid discloses the claimed invention except for a second layer on the opposite of the central layer which forms separate areas on the pad surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place individual sheets of plastic material on the opposite side of the central layer which are sealed to the central layer to

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form inflatable areas having their own valve control on the surface of the article, since it has been held that mere duplication of the essential working parts of an article involves only routine skill in the art. *St. Regis Co. v. Bemis Co.*, 193 USPQ 8.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the chambers of the inflatable packing pad.

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One skilled in the art would have been motivated to do so in order to use the entire inflatable space formed when the two pieces are sealed together.

Response to Arguments

10. Applicant's arguments filed in Paper #3 regarding the 35 U.S.C. 112 rejections of record have been considered but are moot since the rejections have been withdrawn. A new rejection to the amended language has been added.

11. Applicant's arguments filed in Paper #3 regarding the 35 U.S.C. 102 rejection of claims 1 and 2 as anticipated by Jaszai and the 35 U.S.C. 103 rejection of claim 3 over Jaszai have been carefully considered but are moot due to the new grounds of rejection. However, since Jaszai was applied to in the rejections above, the arguments presented by the Applicant will be responded to below.

In response to Applicant's argument that shape of the zones are an important part of the invention leading to a higher impact protection, one of ordinary skill in the art would have recognized the gained advantages by the conical or triangular shape, a higher volume profile, since one of ordinary skill would know through the use of simple general geometry calculations to that the conical shape would give a higher profile to the filled zone. Therefore, one of ordinary skill in the art could readily determine the optimum shape to have a higher profile when inflated depending on the end desired results absence of unexpected results.

In response to applicant's argument that there are several basic differences of the intended use between the recited references and the claimed invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Even though the references are intended for wrapping an item for packaging, the packaging elements are able to be used for the same purpose if placed around the item in a box.

In response to Applicant's argument that the references used in the rejections have valves, which is additional structure not required by Applicant's invention. It must be noted that the references disclose the invention as claimed. The fact that they disclose additional structure not claimed is irrelevant since the claim language is open language, i.e. "comprising". When open language is present in the claims, the references may include additional structure as long as the claimed elements of the invention are still met. In this case, the valve can read on the claimed entry/exit tube. In order for the references to no longer be applied, there needs to be a limitation in the claim that states that the packaging element is free from valves.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the ability of

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the packaging element to redistribute air when a chamber is compressed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant's arguments filed in Paper #3 regarding the 35 U.S.C. 103 rejection of claim 4 over Magid have been carefully considered but are moot due to the new grounds of rejection. However, since Magid was applied to in the rejections above, the arguments presented by the Applicant will be responded to below.

In response to Applicant's argument that shape of the zones are an important part of the invention leading to a higher impact protection, one of ordinary skill in the art would have recognized the gained advantages by the conical or triangular shape, a higher volume profile, since one of ordinary skill would know through the use of simple general geometry calculations to that the conical shape would give a higher profile to the filled zone. Therefore, one of ordinary skill in the art could readily determine the optimum shape to have a higher profile when inflated depending on the end desired results absence of unexpected results.

In response to applicant's argument that Magid fails to disclose an impact resistant wrapping packing system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Even though the references are intended for inflatable articles, the articles could still be used to fill void space in a box.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., each zone controls a complete side of a pad and the air moves freely through all connected cone shaped air chambers in a zone) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In order to differentiate between the claimed article from the applied references, the claims need to clearly state the structure of the claimed invention which makes it different from the references, i.e. each zone controlling a complete side of the pad.

In response to Applicant's argument that the references used in the rejections have valves, which is additional structure not required by Applicant's invention. It must be noted that the references disclose the invention as claimed. The fact that they disclose additional structure not claimed is irrelevant since the claim language is open language, i.e. "comprising". When open language is present in the claims, the references may include additional structure as long as the claimed elements of the invention are still met. In this case, the valve can read on the

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claimed entry/exit tube. In order for the references to no longer be applied, there needs to be a limitation in the claim that states that the packaging element is free from valves.

In response to Applicant's argument that by providing Magid with a second film layer would not provide a high profile pad with four separate zones, it would be obvious to one of ordinary skill to form the same chambers on the underside of Magid as formed in Figure 4. Duplicating a part of an invention requires only routine skill in the art, and by forming the chambers on the underside of the article, the layer to which the individual sheets are attached inherently becomes the central layer.

13. Applicant's arguments filed in Paper #3 regarding Soroka et al., which was cited to show the state of the art considered but are moot since Soroka was only cited due to its closeness to the art. The reference was not used in the rejection because it did not read on the claims as written.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln

March 10, 2003

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

3/17/03